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REMARKS

Upon entry of the present Amendment the claims under consideration are 1-20. All Claims except Claim 14 have been amended hereby. Applicant has hereby amended the drawings to remove the graph lining background of the originally filed drawings. The Examiner's Action of 15 June 2001 will now be addressed with reference to the headings and any paragraph numbers therein.

Claim Rejections 35 USC §112

Per the Examiner's paragraph 2, Claims 1-14 stand rejected under 35 USC §112 because the limitation "advertisements" in Claims 1 and 8, lines 7 and 10, respectively, are deemed by the Examiner to lack antecedent basis. Applicants respectfully traverse this rejection noting that the defining phrase of the limitation before the present amendment was "an invoice for advertisements" and that the definite article was not applied to this phrase. Applicants believe the claims originally filed comported with 35 USC §112 and are further made even more clear to the relevant public as presently amended.

Claim Rejections 35 USC §103

Per the Examiner's paragraph 4, Claims 1-20 stand rejected under 35 USC §103 as obvious over Goodman et. (US 6,173,217, hereinafter "Goodman") in view of Bednar et al. (EP 0 745 947 A2, hereinafter "Bednar").

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It is the Examiner's contention that Goodman discloses the claimed device except for: "invoicing database regarding the inclusion of the steps of creating a second digital document representing an invoice and copying digital invoice items ("documents") to an invoice database and storing the first and second documents in a common file; the step of listing each invoice item as a line item; displaying the "documents" in human readable form; creating a third digital document representing a publication page containing the inventory items; and storing the published page document in a common file associated with the invoice document."

Applicants respectfully submit that, given the amount of the present invention that the Examiner admits Goodman is silent on, Goodman does not "disclose the claimed device", and cannot be used to establish a *prima facie* case of obviousness against the present invention.

By way of general discussion: Goodman does not address the compilation and association of print publication images but merely teaches a broadcast based system which is time based to encode and encrypt broadcast advertising identifiers and record the occurrence (broadcast) of the advertisement. Thus it is a temporally based system and not a document based system. Goodman does not suggest the association of an advertisement image with a publication page image and the association of each of these images together and with a billing statement line item. The end result of Goodman is a billing statement without

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associated images of the advertisement or the publication page on which the advertisement was published. Thus the person having ordinary skill in the art of print publication advertising sales would not be led to the present invention through the teachings of Goodman.

Further, Applicants traverse the Examiner's general statements concerning the teachings of Bednar since the general statements of the Detailed Action concerning Bednar's teachings do not appear to correspond to the specifically claimed subject matter in so far as the Applicants understand the rejection. Clarification is requested should the Examiner maintain the present rejections. The Examiner, at page 3 of the Detailed Action, appears to be citing the "invoice of Fig. 4" as both the second document and third document and equating the invoice document to the publication page document of the present invention, which publication page document is specified in the present invention (e.g. Claim 5) as containing the billed-for advertisement (not found in Bednar).

Further, Applicants contest the combination of Goodman and Bednar, since Bednar cannot supply the missing teachings of Goodman with respect to the present invention. Bednar, does not teach a method of constructing an invoice, and especially an invoice suitable for the print publication industry. Bednar merely teaches an electronic clearing house for premade billing statements which are then compiled and routed to the customer. The compilation may then be electronically

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manipulated and items therein paid and tracked electronically within the ordinary course of business by the customer. Bednar does not construct invoices *per se* and does not deal with advertisement images or the publication page images in which the advertisements appear and does not suggest associating the line items of the invoice with the particular images for which the customer is billed. Thus the person having ordinary skill in the art of print publication advertising sales would not be led to the present invention through the teachings of Bednar. Because Bednar and Goodman do not share a common functionality or ways to achieve that functionality, the references are not properly combinable. For all the foregoing reasons, the Applicants respectfully request that the Examiner reconsider and withdraw the present rejections.

The additionally cited references have been reviewed and are not believed to be any more relevant to the present invention than the applied references.

Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner. The undersigned can be reached at (847) 490-1400.

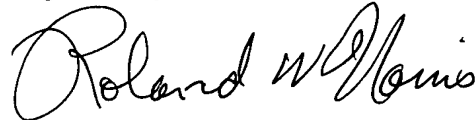


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Applicants sincerely believe that this patent application is now in condition for allowance and, thus, respectfully request early allowance.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Regis. No. 32,799

Pauley Petersen Kinne & Fejer
2800 West Higgins Road, Suite 365
Hoffman Estates, Illinois 60195
PHONE: (847) 490-1400
FAX: (847) 490-1403

MARKED-UP VERSION SHOWING CHANGES MADE

In the Claims

1. (Amended) A method of constructing a billing statement comprising:
 - a. establishing a unique customer identifier for each customer;
 - b. creating a first digital document representing an advertisement image with a unique advertisement identifier and associating the customer identifier with [said] the advertisement identifier;
 - c. creating a second digital document representing an invoice for advertisements;
 - d. finding the [advertisement documents] first digital document in a first advertisement [data base] database and copying the [advertisements] first digital document to an invoice database; and
 - e. storing the first and second digital documents in a common file.
2. (Amended) The method of claim 1 including the further step of copying the first and second digital documents to a removable storage medium.

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3. (Amended) The method of claim 1 including the further step of listing each [advertisement] first digital document as a line item on the [invoice] second digital document.

4. (Amended) The method of claim 1 including the further step of displaying the first and second digital documents in human readable format.

5. (Amended) The method of claim 1 [father] further including the step of creating a third digital document representing a publication page image containing the advertisement image and associating the [publication page] third digital document with [said] the unique advertisement identifier.

6. (Amended) The method of claim 5 [father] further including the step of finding the third digital document [published page of] containing the advertisement in a second publication [data base] database and copying the third digital document [published page] to the invoice database.

7. (Amended) The method of claim 6 [father] further including the step of storing the [published page] third digital document in a common file associated with the [invoice] second digital document.

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8. (Amended) A method of constructing a billing statement comprising:

- a. establishing a unique customer identifier for each customer;
- b. creating a first digital document representing an advertisement image with a unique advertisement identifier and associating the unique customer identifier with [said] the unique advertisement identifier;
- c. creating a second digital document representing a publication page image with the advertisement image and associating the publication page image with [said] the unique advertisement identifier;
- d. creating a third digital document representing an invoice for advertisements including specifying an identifier range for invoiced advertisements;
- e. finding the [advertisement documents] first digital document by searching the unique customer identifier in a first [data base] database and copying the [advertisements] first digital document to an invoice database and listing each found [advertisement] first digital document as a line item on the invoice;
- f. finding the [published page of the advertisement] second digital document and copying the [published page] second digital document to the invoice database;[*and*] and
- g. storing the first and second digital documents in a common file associated with the [invoice] third digital document.

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9. (Amended) The method of claim 8 further including finding the [published page] second digital document by searching the unique advertisement identifier.

10. (Amended) The method of claim 8 further including finding the [published page] second digital document by searching the unique customer identifier.

11. (Amended) The method of claim 8 including the further step of copying the first, second, and third digital documents to a removable storage medium.

12. (Amended) The method of claim 8 including the further step of listing each advertisement [document] identifier as a line item on the invoice document.

13. (Amended) The method of claim 8 including the further step of displaying the first, second, and third digital documents in human readable format.

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15. (Amended) A method of constructing a billing statement for published advertisements comprising:

a. establishing a unique customer identifier for a customer to be billed;

b. creating a [first] digital [document representing a] billing invoice document and associating the digital billing invoice document with the unique customer identifier and storing the digital billing invoice document in an invoice file;

c. creating a [second] digital [document representing an] advertisement document with a unique advertisement identifier and associating the unique customer identifier with the unique advertisement identifier and storing the digital advertisement document in an advertisement database;

d. creating a [third] digital [document representing a] publication page, with the digital advertisement document thereon, and having a unique page identifier; and associating the unique [publication] page identifier with [said] the unique advertisement identifier and storing the digital publication page document in a publication page database;

e. searching for digital advertisement documents in the advertisement [data base] database according to the customer identifier, identifying digital advertisement documents according to the customer identifier, and copying [the] identified digital advertisement documents to the invoice file;

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f. searching for digital publication pages associated with the digital advertisement documents in the publication page database and copying the associated digital publication pages to the invoice file; and

g. cross referencing the [first, second, and third] billing invoice, advertisement, and publication page digital documents in the invoice file .

16. (Amended) The method of claim 15 including the further step of copying the billing invoice, advertisement, and publication page digital documents to a removable storage medium.

17. (Amended) The method of claim 15 including the further step of listing each digital advertisement document as a line item on the invoice document.

18. (Amended) The method of claim 17 including the further step of displaying the [first, second, and third] billing invoice, advertisement, and publication page digital documents in human readable format.

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19. (Amended) The method of claim 17 wherein the step of creating [a third] ~~the~~ digital billing invoice document [representing an invoice for advertisements] includes specifying an identifier range for the digital advertisement documents.

20. (Amended) The method of claim 19 wherein the step of specifying an identifier range further includes specifying a date range on which the [advertisements] digital advertisement documents were published in print.

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